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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/024,982	12/18/2001	Lester D. Nelson	FXA0015	4818
23910	7590	11/17/2005	EXAMINER HASHEM, LISA	
FLIESLER MEYER, LLP FOUR EMBARCADERO CENTER SUITE 400 SAN FRANCISCO, CA 94111			ART UNIT 2645	

DATE MAILED: 11/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center">Office Action Summary</p>	Application No. 10/024,982		Applicant(s) NELSON ET AL.	
	Examiner Lisa Hashem		Art Unit 2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8-2-2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The affidavit filed on 8-2-05 under 37 CFR 1.131 has been considered but is ineffective to overcome the Cannell reference.
2. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Cannell reference to either a constructive reduction to practice or an actual reduction to practice. Exhibit 1 does not disclose diligence of the inventions in claims 1-8, 9-18, 19-22, 23-26, 27-34, and 35-41. There is no evidence of data results and testing of the proposal in Exhibit 1. Further, Exhibit 1 fails to disclose diligence relating to the invention in claims 19-22, wherein a scanning device is coupled with the processing device.
3. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Cannell reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). Exhibit 1 fails to disclose conception relating to the invention in claims 19-22, wherein a scanning device is coupled with the processing device.
4. The evidence submitted is insufficient to establish applicant's alleged actual reduction to practice of the invention in this country or a NAFTA or WTO member country after the effective date of the Cannell reference. Exhibit 1 fails to disclose an actual reduction to practice of the inventions in claims 1-8, 9-18, 19-22, 23-26, 27-34, and 35-41. There is no evidence of the invention successfully used in the telecommunications industry and data results provided of the

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invention. Also, page 14 of Exhibit 1 discloses in lines 4-5, '... There is still a need to conduct user-centered design for creating specific interfaces for the scenarios described here...' which is evidence that there is still need for improvement of the proposal disclosed in Exhibit 1. Further, Exhibit 1 fails to disclose an actual reduction to practice of the invention in claims 19-22, wherein a scanning device is coupled with the processing device.

5. Accordingly, the Non-Final Rejection filed on 4-7-2005 has not been overcome and is still maintained (Cannell is still considered prior art). That rejection has not been included below. Additionally, the Examiner has provided multiple backup rejections to further reject this application. Please see all rejections below.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1, 9, and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "not necessarily" in claims 1, 9, and 27 is a relative term which renders the claim indefinite. The term "not necessarily" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is not clear whether initiating a new communication is in response to an incoming communication or whether initiating a new communication is not in response to an incoming communication.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 3 recites the limitation "the internal phrase element". There is insufficient antecedent basis for this limitation in the claim.

10. Claim 36 recites the limitation "said input". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1, 3, and 8 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by U.S. Patent No. 5,764,748 by Rosenthal et al, hereinafter Rosenthal.

Regarding claim 1, Rosenthal discloses a method for a user to communicate over multiple channels (see Abstract; see Fig. 1), comprising steps of:

(a) communicating over a first channel (e.g. first call); and

(b) initiating a new communication, which is not necessarily responding to an incoming communication (e.g. responding to an incoming second call signal (e.g. call waiting)) (col. 1, lines 16-24; col. 2, lines 6-15 and lines 30-44; col. 5, line 57 – col. 6, line 8; col. 6, line 18 – col. 8, line 3), by performing the following steps:

(1) selecting a second channel (e.g. a second call) (e.g. send a speech signal to a second caller);

(2) selecting a phrase (e.g. Call me later or Call me back in forty five minutes);

(3) generating an audible utterance representative of the selected phrase; and

(4) providing the audible utterance over the selected second channel only while communicating over the first channel concurrently (col. 8, lines 4-13; col. 8, line 29 –col. 12, line 29).

Regarding claim 3, the method of claim 1, wherein Rosenthal further discloses the step of generating an audible utterance includes the step of obtaining an internal representation of a phrase element associated with the selected phrase and generating an audible utterance based on an internal phrase element (col. 4, lines 54-64; col. 8, lines 4-13; col. 8, line 29 –col. 12, line 29).

Regarding claim 8, the method of claim 1, wherein Rosenthal further discloses the step generating an audible utterance includes text-to-speech processing (col. 4, lines 54-64; col. 8, lines 4-13; col. 8, line 29 –col. 12, line 29).

13. Claims 27, 28, 30, 32, and 34 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Rosenthal.

Regarding claim 27, Rosenthal discloses a telecommunication infrastructure (see Fig. 1 and Abstract), comprising:

- (a) a first electronic device coupled to the telecommunication infrastructure over a first channel (Fig. 1, 21);
 - (b) a second electronic device coupled to the telecommunication infrastructure over a second channel (Fig. 1, 201);
 - (c) a third electronic device, coupled to the telecommunication infrastructure (Fig. 1, 11), selecting the first channel or the second channel and selecting a phrase representation not necessarily in response to an incoming communication (e.g. selecting the second channel in response to an incoming second call signal (e.g. call waiting)) (col. 8, line 29 –col. 12, line 29);
- and,

(d) a processing device (Fig. 1, 100), coupled to the telecommunication infrastructure, capable of storing:

- 1) a phrase element associated with the phrase representation; and,
- 2) a software program for providing an audible utterance over the selected first or second channel only in response to a selected phrase representation while permitting the third electronic device to hold the communication concurrently over the unselected second or first channel (col. 4, lines 24-64; col. 8, lines 4-13; col. 8, line 29 –col. 12, line 29).

Regarding claim 28, the telecommunication infrastructure of claim 27, wherein Rosenthal further discloses the third electronic device generates an in-band signal in response to a phrase representation selection and a channel representation selection (col. 8, line 29 –col. 12, line 29).

Regarding claim 30, the telecommunications infrastructure of claim 28, wherein Rosenthal further discloses the signal is a Dual-Tone Multi Frequency (“DTMF”) signal (*1) (col. 8, line 29 –col. 12, line 29).

Regarding claim 32, the telecommunications infrastructure of claim 27, wherein Rosenthal further discloses the phrase representation is selected from a group consisting of a text and a label (col. 4, lines 54-64; col. 8, line 29 –col. 12, line 29).

Regarding claim 34, the telecommunication infrastructure of claim 27, wherein Rosenthal further discloses the processing device is a relay between the first electronic device, the second electronic device, and the third electronic device (Fig. 1, 100; col. 4, lines 24-64).

14. Claims 35-38 and 40 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Rosenthal.

Regarding claim 35, Rosenthal discloses a method for a user to communicate with a plurality of recipients over a plurality of channels (see Abstract), comprising steps of:

- (a) communicating over a first channel with a first recipient (e.g. first call);
- (b) receiving an indication over a second channel of a second recipient (via Call Waiting) (col. 1, lines 16-24; col. 2, lines 6-15 and lines 30-44; col. 5, line 57 – col. 6, line 8; col. 6, line 18 – col. 8, line 3);
- (c) selecting a channel for generating an audible utterance (e.g. send a speech signal to a second caller);
- (d) selecting a phrase representation (e.g. Call me later or Call me back in forty five minutes); and
- (e) generating an audible utterance only over said selected channel while communicating over the first channel concurrently (col. 8, lines 4-13; col. 8, line 29 – col. 12, line 29).

Regarding claim 36, the method of claim 35, wherein Rosenthal further discloses audio input from said first and second channel are mixed (col. 10, line 57 – col. 11, line 34).

Regarding claim 37, the method of claim 35, wherein Rosenthal further discloses including the step of: obtaining an internal representation of a phrase element (e.g. text) associated with said selected phrase representation (e.g. Call me later or Call me back in forty five minutes) (col. 4, lines 54-64).

Regarding claim 38, the method of claim 35, wherein Rosenthal further discloses said step of selecting a channel for generating an audible utterance includes the steps of: accessing a channel representation; and, selecting a channel representation (e.g. by dialing the code *1 to

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select the second caller or calling subscriber to receive an audible utterance) (col. 8, line 36 – col. 9, line 4; col. 9, line 13 – col. 10, line 56).

Regarding claim 40, the method of claim 35, wherein Rosenthal further discloses said step of selecting a phrase for generating an audible utterance includes the steps of: accessing a phrase representation; and, selecting a phrase representation (col. 4, lines 54-64; col. 8, line 36 – col. 9, line 4; col. 9, line 13 – col. 10, line 56).

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 2 and 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenthal, in view of U.S. Patent No. 6,366,578 by Johnson.

Regarding claim 2, the method of claim 1, wherein Rosenthal does not disclose selecting a second channel further includes selecting a plurality of channels.

Johnson discloses a method for a user or office attendant-type program user to communicate over multiple channels (see Fig. 8A: Lines 1-5), comprising steps of: (a) communicating over a first channel (wherein the office attendant-type program receives an incoming call for a particular user, Mike; Fig. 9B); (b) initiating a new communication, which is not necessarily responding to an incoming communication (an office attendant-type program user sending a Net Message to called party Mike; Fig. 10A; col. 28, lines 18-57), by performing the following steps: (1) selecting a second channel (sending a Net Message to Mike; Fig. 10A);

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(2) selecting a phrase (col. 28, lines 18-57); (3) generating a net message of the selected phrase; and (4) providing the net message over the selected second channel only while the first channel is on hold concurrently (col. 26, lines 27-39; see Fig. 10B; col. 28, line 59 – col. 29, line 7).

Wherein Johnson further discloses a selecting a second channel further includes selecting a plurality of channels, wherein the office attendant-type program user sets up a conference call with various users (Fig. 11A-11E; col. 30, line 1 – col. 31, line 26).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the method of Rosenthal to include selecting a second channel further includes selecting a plurality of channels as taught by Johnson. One of ordinary skill in the art would have been lead to make such a modification since more than one recipient on a plurality of channels can receive a message from the user.

Regarding claim 4, the method of claim 1, wherein Rosenthal further discloses the step of selecting a second channel includes DTMF tones (col. 8, line 29 –col. 12, line 29).

Rosenthal does not disclose the step of selecting a second channel includes selecting a graphical representation of said second channel using a graphical user interface.

Johnson discloses a method for a user or office attendant-type program user to communicate over multiple channels (see Fig. 8A: Lines 1-5), comprising steps of: (a) communicating over a first channel (wherein the office attendant-type program receives an incoming call for a particular user, Mike; Fig. 9B); (b) initiating a new communication, which is not necessarily responding to an incoming communication (an office attendant-type program user sending a Net Message to called party Mike; Fig. 10A; col. 28, lines 18-57), by performing the following steps: (1) selecting a second channel (sending a Net Message to Mike; Fig. 10A);

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(2) selecting a phrase (col. 28, lines 18-57); (3) generating a net message of the selected phrase; and (4) providing the net message over the selected second channel only while the first channel is on hold concurrently (col. 26, lines 27-39; see Fig. 10B; col. 28, line 59 – col. 29, line 7).

Wherein Johnson further discloses the step of selecting a second channel includes selecting a graphical representation of said second channel using a graphical user interface (Fig. 9A and Fig. 9B).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the method of Rosenthal to include the step of selecting a second channel includes selecting a graphical representation of said second channel using a graphical user interface as taught by Johnson. One of ordinary skill in the art would have been lead to make such a modification to provide a graphical user interface that would allow the user to view first and second channels and to select a second channel to send an audible utterance to via the graphical user interface.

Regarding claim 5, the method of claim 1, wherein Rosenthal further discloses the step of selecting a phrase includes DTMF tones (col. 8, line 29 –col. 12, line 29).

Rosenthal does not disclose the step of selecting a phrase includes selecting a graphical representation of said phrase using a graphical user interface.

Johnson discloses a method for a user or office attendant-type program user to communicate over multiple channels (see Fig. 8A: Lines 1-5), comprising steps of: (a) communicating over a first channel (wherein the office attendant-type program receives an incoming call for a particular user, Mike; Fig. 9B); (b) initiating a new communication, which is not necessarily responding to an incoming communication (an office attendant-type program

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user sending a Net Message to called party Mike; Fig. 10A; col. 28, lines 18-57), by performing the following steps: (1) selecting a second channel (sending a Net Message to Mike; Fig. 10A); (2) selecting a phrase (col. 28, lines 18-57); (3) generating a net message of the selected phrase; and (4) providing the net message over the selected second channel only while the first channel is on hold concurrently (col. 26, lines 27-39; see Fig. 10B; col. 28, line 59 – col. 29, line 7).

Wherein Johnson further discloses the step of selecting a phrase includes selecting a graphical representation of said phrase using a graphical user interface (Fig. 10A; col. 28, lines 18-57).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the method of Rosenthal to include the step of selecting a phrase includes selecting a graphical representation of said phrase using a graphical user interface as taught by Johnson. One of ordinary skill in the art would have been lead to make such a modification to provide a graphical user interface that would allow the user to view multiple phrase representations, select one of the phrase representations, and send it to the second channel via the graphical user interface.

Regarding claim 6, the method of claim 5, wherein Johnson further discloses the graphical representation of said phrase is selected from a group consisting of an icon, a symbol, a figure, a graph, a checkbox, a GUI widget, a graphics button, and a pulldown menu button (Fig. 10A; col. 28, lines 18-57).

Regarding claim 7, the method of claim 1, wherein Rosenthal further discloses said internal representation of said selected phrase is obtained from switch (col. 4, lines 24-64).

Rosenthal does not disclose said internal representation of said selected phrase is obtained from a host computer.

Johnson discloses a method for a user or office attendant-type program user to communicate over multiple channels (see Fig. 8A: Lines 1-5), comprising steps of: (a) communicating over a first channel (wherein the office attendant-type program receives an incoming call for a particular user, Mike; Fig. 9B); (b) initiating a new communication, which is not necessarily responding to an incoming communication (an office attendant-type program user sending a Net Message to called party Mike; Fig. 10A; col. 28, lines 18-57), by performing the following steps: (1) selecting a second channel (sending a Net Message to Mike; Fig. 10A); (2) selecting a phrase (col. 28, lines 18-57); (3) generating a net message of the selected phrase; and (4) providing the net message over the selected second channel only while the first channel is on hold concurrently (col. 26, lines 27-39; see Fig. 10B; col. 28, line 59 – col. 29, line 7). Wherein Johnson further discloses said internal representation of said selected phrase is obtained from a host computer (wherein the office attendant-type program is located on a host computer) (col. 19, lines 26-30; Fig. 8A and Fig. 10A; col. 28, lines 18-57).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the method of Rosenthal to include said internal representation of said selected phrase is obtained from a host computer as taught by Johnson. One of ordinary skill in the art would have been lead to make such a modification to allow a phrase to be obtained from a host computer that is remote from the user and is used to store phrases.

17. Claims 9-12 and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of Rosenthal.

Regarding claim 9, Johnson discloses a multi-channel telecommunication system (see Fig. 8A: Lines 1-5; Fig. 9A), comprising:

- (a) an audio input or telephone (col. 17, line 48 – col. 18, line 36);
- (b) a channel representation (Fig. 9A and Fig. 9B);
- (c) a phrase representation (Fig. 10A; col. 28, lines 18-57);
- (d) a display capable of displaying a channel representation and a phrase representation (Fig. 8A; Fig. 9A, Fig 10A);
- (e) a memory or computer (Fig. 2, 24) capable of storing the channel representation, phrase representation, and phrase element associated with the phrase representation, wherein the phrase element has an internal representation of a text message (col. 17, line 48 – col. 18, line 36);
- (f) a processor or office attendant-type program, coupled to the audio input, display, and memory, wherein the processor initiates a first control signal and a second control signal not necessarily in response to an incoming communication (e.g. an office attendant-type program user sending a Net Message to called party Mike; Fig. 10A; col. 28, lines 18-57);
- (g) a text generator (utilizing Net Messaging), coupled to the processor and memory, wherein the text generator generates a text responsive to the first control signal and the phrase element (col. 22, lines 38-44); and,
- (h) a channel selector, coupled to the processor and text generator, wherein the channel selector selects a channel responsive to the second control signal and provides the text message over the selected channel only while communicating over another channel concurrently (col. 26, lines 16-26).

Johnson does not disclose the phrase element has an internal representation of an audible utterance and an audio generator.

Rosenthal discloses a multi-channel telecommunication system (Fig. 1), comprising:

- (a) an audio input or telephone (Fig. 1: 11, 21);
- (b) a channel representation (e.g. alert for an incoming second caller);
- (c) a phrase representation (e.g. visual display of the calling party name);
- (d) a display capable of displaying a channel representation and a phrase representation (Fig. 1, 11; col. 2, lines 6-12);
- (e) a memory or switch (Fig. 1, 100) capable of storing the channel representation, phrase representation, and phrase element associated with the phrase representation, wherein the phrase element has an internal representation of an audible utterance (col. 4, lines 24-64);
- (f) a processor (e.g. button presses), coupled to the audio input, display, and memory, wherein the processor initiates a first control signal and a second control signal not necessarily in response to an incoming communication (e.g. responding to an incoming second call signal (e.g. call waiting)) (col. 1, lines 16-24; col. 2, lines 6-15 and lines 30-44; col. 5, line 57 – col. 6, line 8; col. 6, line 18 – col. 8, line 3);
- (g) an audio generator (Fig. 1, 117), coupled to the processor and memory, wherein the audio generator generates an audible utterance responsive to the first control signal and the phrase element (col. 4, lines 54-64); and,
- (h) a channel selector, coupled to the processor and audio generator, wherein the channel selector selects a channel responsive to the second control signal and provides the text message over the selected channel only while communicating over another channel concurrently (col. 3, line 66 – col. 4, line 9).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the system of Johnson to include an audio generator and provide an audible

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utterance over the selected channel as taught by Rosenthal. One of ordinary skill in the art would have been lead to make such a modification since an audio generator generates an audible utterance associated with a phrase representation to be sent on a selected channel.

Regarding claim 10, the multi-channel telecommunication system of claim 9, wherein Rosenthal further discloses said multi-channel telecommunication system is a telephone (Fig. 1, 11).

Regarding claim 11, the multi-channel telecommunication system of claim 9, wherein Rosenthal further discloses the multi-channel telecommunication system further comprises:
(i) an audio mixer, coupled to the processor and channel selector, mixing audio received from said channel selector (col. 10, line 57 – col. 11, line 9).

Regarding claim 12, the multi-channel telecommunication system of claim 9, wherein Johnson further discloses the phrase representation and channel representation are displayed in a graphic user interface (GUI) (Fig. 9A and Fig. 10A).

Regarding claim 14, the multi-channel telecommunication system of claim 9, wherein Johnson further discloses the channel representation is selected from a group consisting of a text and a label (Fig. 10A; col. 28, lines 18-57).

Regarding claim 15, the multi-channel telecommunication system of claim 9, wherein Rosenthal further discloses the internal representation is in a format selected from a group consisting of a sound file, a record or playback, a text, and a Musical Instrument Digital Interface ("MIDI") sequence (col. 4, lines 54-64; col. 9, line 24 – col. 11, line 29).

Regarding claim 16, the multi-channel telecommunication system of claim 9, wherein Johnson further discloses the internal representation is obtained from a host computer (Fig. 2, 50) (col. 28, lines 18-57).

Regarding claim 17, the multi-channel telecommunication system of claim 9, wherein Johnson further discloses the first control signal is inherently generated in response to a user selecting the phrase representation and the second control signal is inherently generated in response to a user selecting the channel representation (col. 28, lines 18-57).

Regarding claim 18, the multi-channel telecommunication system of claim 9, wherein Johnson further discloses the phrase representation and channel representation are selected from a group consisting of a button, a switch, a barcode, a label, a glyph, and Braille (Fig. 9A and Fig. 10A; col. 28, lines 18-57).

18. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of Rosenthal, as applied to claim 9 above, and in further view of U.S. Patent No. 5,894,504 by Alfred et al, hereinafter Alfred.

Regarding claim 13, the multi-channel telecommunication system of claim 9, wherein Johnson in view of Rosenthal do not disclose the multi-channel telecommunication system further comprises: (h) an audio monitor, coupled to the processor of channel selector, monitoring an audio level received from said channel selector.

Alfred discloses a method for a user or called party to communicate with a plurality of recipients over a plurality of channels (see Abstract; Fig. 3), comprising steps of: (a) communicating over a first channel with a first recipient (first caller) (Fig. 3, 301); (b) receiving an indication over a second channel of a second recipient (via Call Waiting) (Fig. 3, 305; col. 3,

line 36 - col. 4, line 9; col. 5, line 50 – col. 6, line 18); (c) selecting to receive advanced messaging service by dialing *33 (Fig. 3, 307); (d) the second call-in-waiting caller records a message (Fig. 3: 308, 309); and (e) audio input from said first and second channel are mixed and can be heard by the user (col. 7, lines 15-37). Wherein an audio monitor or communications switch (Fig. 1, 105), coupled to a processor or message processing system (Fig. 1, 109) and channel selector or voice messaging system (Fig. 1, 112), monitoring an audio level received from said channel selector (col. 4, lines 10-65; col. 7, lines 15-37).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Johnson in view of Rosenthal to include an audio monitor as taught by Alfred. One of ordinary skill in the art would have been lead to make such a modification since mixed audio input can allow the user to hear the audio input from the channels simultaneously and the user can hear both conversations of the channels at different audio levels.

19. Claims 19-22 rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 6,941,342 by Nelson in view of Rosenthal.

The applied reference has a common assignee and at least one common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention “by another”; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the

effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Regarding claim 19, Nelson discloses a system (see Abstract), comprising:

- (a) a plurality of input channels (col. 6, lines 40-57);
- (b) a processing device for storing an internal representation of a phrase element; and,
- (c) a scanning device, coupled with the processing device, for reading a first code associated with the phrase element, wherein the processing device provides an audible utterance only over the channel in response to reading the first code while communicating over another channel concurrently (e.g. while a user is in a meeting or in a conference call) (Figs. 10-12; col. 13, lines 20-62).

Nelson does not disclose reading a second code associated with at least one of the plurality of input channels.

Rosenthal discloses a system (Fig. 1), comprising:

- (a) a plurality of input channels (Fig. 1: 21, 201);
- (b) a processing device for storing an internal representation of a phrase element (Fig. 1: 117, 118; col. 4, lines 54-64); and,
- (c) reading a first code associated with the phrase element ('1') and for reading a second code associated with at least one of the plurality of input channels (*) (e.g. DTMF tones), wherein

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processing device initiates to provides an audible utterance only over the channel in response to reading the first code and the second code while communicating over another channel concurrently (e.g. while communicating with a first caller) (col. 8, lines 4-13; col. 8, line 29 –col. 12, line 29).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Nelson to include a second code as taught by Rosenthal. One of ordinary skill in the art would have been lead to make such a modification since a second code can be used to specify which channel to send an audible utterance to.

Regarding claim 20, the system of claim 19, wherein Rosenthal further discloses the processing device includes: a channel selection device (Fig. 1: 110, 120), for selecting at least one of the plurality of input channels responsive to said second code (col. 3, line 66 – col. 4, line 9).

Regarding claim 21, the system of claim 19, wherein Nelson further discloses the scanning device is a barcode scanner (Fig. 11, 113).

Regarding claim 22, the system of claim 19, wherein Nelson further discloses the scanning device is a laser scanner (Fig. 10, 104).

20. Claims 19-22 provisionally rejected under 35 U.S.C. 103(a) as being obvious over copending Application No. 09/658,243 which has a common assignee and at least one common inventor with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e) if published or patented (Note: Notice of Allowance has been mailed on 9-12-2005). This provisional rejection

under 35 U.S.C. 103(a) is based upon a presumption of future publication or patenting of the conflicting application.

Nelson discloses a scanning device that can read a first code that represents an audible utterance to send over a channel (see disclosure of invention). It would be obvious to modify this invention to include second code (as taught by Rosenthal) to select a channel to send an audible utterance to another channel while concurrently communicating with a first channel.

This provisional rejection might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by a showing of a date of invention for the instant application prior to the effective U.S. filing date of the copending application under 37 CFR 1.131. This rejection might also be overcome by showing that the copending application is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

21. Claims 19-22 rejected under 35 U.S.C. 103(a) as being obvious over Rosenthal in view of U.S. Patent No. 6,766,007 by Dermuler et al, hereinafter Dermuler.

Regarding claim 19, Rosenthal discloses a system (Fig. 1), comprising:

- (a) a plurality of input channels (Fig. 1: 21, 201);
- (b) a processing device for storing an internal representation of a phrase element (Fig. 1: 117, 118; col. 4, lines 54-64); and,
- (c) reading a first code associated with the phrase element ('1') and for reading a second code associated with at least one of the plurality of input channels (*) (e.g. DTMF tones), wherein processing device initiates to provides an audible utterance only over the channel in response to

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reading the first code and the second code while communicating over another channel concurrently (e.g. while communicating with a first caller) (col. 8, lines 4-13; col. 8, line 29 – col. 12, line 29).

Rosenthal does not disclose a scanning device coupled to the processing device.

Dermuler discloses a system (see Abstract; Fig. 1A), comprising:

- (a) an input channel (e.g. called person; Fig. 1A, 2);
- (b) a processing device (e.g. computer system) for storing an internal representation of a phrase element (col. 5, line 62 – col. 6, line 17); and,
- (c) a scanning device (e.g. scanner (Fig. 1A, 4; Fig. 2, 214) or bar-code reader (Fig. 1A, 4)), coupled with the processing device, for reading a first code associated with the phrase element, wherein the processing device provides text only over the channel in response to reading the first code while communicating over the channel concurrently (col. 3, lines 43-63; col. 4, line 34 – col. 5, line 8; col. 5, lines 18-26; col. 5, lines 41-53).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Rosenthal to include a scanning device as taught by Dermuler. One of ordinary skill in the art would have been lead to make such a modification since a scanning device is used to send call-related information to a channel.

Regarding claim 20, the system of claim 19, wherein Rosenthal further discloses the processing device includes: a channel selection device (Fig. 1: 110, 120), for selecting at least one of the plurality of input channels responsive to said second code (col. 3, line 66 – col. 4, line 9).

Regarding claim 21, the system of claim 19, wherein Dermuler further discloses the scanning device is a barcode scanner (col. 4, lines 49-57).

Regarding claim 22, the system of claim 19, wherein Dermuler further discloses the scanning device is a laser scanner (col. 4, lines 49-57; Fig. 2, 214).

22. Claims 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of Rosenthal.

Regarding claim 23, Johnson discloses a general purpose computing device (Fig. 2, 24), comprising:

- (a) a display, capable of displaying a channel representation and a phrase representation (Fig. 8A, Fig. 9A, Fig. 10A);
- (b) a memory or computer (Fig. 2, 24), capable of storing the channel representation, phrase representation, and a phrase element associated with the phrase representation, wherein the phrase element has an internal representation of a text message (col. 17, line 48 – col. 18, line 36);
- (c) a processor or office attendant-type program, coupled to the display and memory, wherein the processor initiates to generate a first control signal responsive to selection of the channel representation and a second control signal responsive to selection of the phrase representation (e.g. an office attendant-type program user sending a pre-generated Net Message to a called party Mike; Fig. 10A; col. 28, lines 18-57);
- (d) a text generator, coupled to the processor and memory, wherein the text generator generates a text responsive to the second control signal and the phrase element (col. 22, lines 38-44); and

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(e) a channel selector, coupled to the processor and text generator, wherein the channel selector activates a channel responsive to the first control signal and provides the text message over the selected channel only while communicating over another channel concurrently (col. 26, lines 16-26).

Johnson does not disclose the phrase element has an internal representation of an audible utterance and an audio generator.

Rosenthal discloses a device (Fig. 1, 11), comprising:

(a) a display, capable of displaying a channel representation (e.g. alert for an incoming second caller) and a phrase representation (e.g. visual display of the calling party name) (col. 2, lines 6-12);

(b) a memory or switch (Fig. 1, 100), capable of storing the channel representation, phrase representation, and a phrase element associated with the phrase representation, wherein the phrase element has an internal representation of an audible utterance (col. 4, lines 24-64);

(c) a processor (e.g. button presses), coupled to the display and memory, wherein the processor initiates to generate a first control signal responsive to selection of the channel representation and responsive to selection of the phrase representation (col. 8, lines 4-13; col. 8, line 29 –col. 12, line 29);

(d) an audio generator (Fig. 1, 117), coupled to the processor and memory, wherein the audio generator generates an audible utterance responsive to the control signal and the phrase element (col. 4, lines 54-64); and

(e) a channel selector, coupled to the processor and audio generator, wherein the channel selector activates a channel responsive to the first control signal and provides the audible utterance over

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the selected channel only while communicating over another channel concurrently (col. 3, line 66 – col. 4, line 9).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the general purpose computing device of Johnson to include the phrase element has an internal representation of an audible utterance and an audio generator as taught by Rosenthal. One of ordinary skill in the art would have been lead to make such a modification to provide a speech message to a channel, wherein an internal phrase representation is selected and speech signals are generated from the phrase representation via text-to-speech processing.

Regarding claim 24, the general purpose computing device of claim 23, wherein Johnson further discloses the display is a touchscreen display (Fig. 8A; col. 23, line 43 – col. 24, line 65).

Regarding claim 25, the general purpose computing device of claim 23, wherein Johnson further discloses the channel representation and phrase representation are displayed in a Graphical User Interface (GUI) (Fig. 9A and Fig. 10A).

Regarding claim 26, the general purpose computing device of claim 23, wherein Johnson further discloses the general purpose computing device is a personal digital assistant, wherein the office attendant-type program may be run remotely (col. 32, lines 8-39).

23. Claims 29, 31, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenthal in view of Johnson.

Regarding claim 29, the telecommunication infrastructure of claim 27, wherein Rosenthal does not disclose the third electronic device generates an out-of-band signal in response to a phrase representation selection and a channel representation selection.

Johnson discloses a telecommunication infrastructure (see Fig. 2 and Abstract), comprising: (a) a first electronic device coupled to the telecommunication infrastructure over a first channel (Fig. 2, 24); (b) a second electronic device coupled to the telecommunication infrastructure over a second channel (Fig. 2, 24); (c) a third electronic device coupled to the telecommunication infrastructure (Fig. 2, 24; col. 17, line 48 – col. 18, line 36), selecting the first channel or the second channel and selecting a phrase representation not necessarily in response to an incoming communication (an office attendant-type program user sending a Net Message to called party Mike; Fig. 10A; col. 28, lines 18-57); and (d) a processing device (communications system; Fig. 2, 50; col. 7, lines 16-47) coupled to the telecommunication infrastructure, capable of storing: 1) a phrase element associated with the phrase representation (col. 28, lines 18-57); and, 2) a software program for providing a Net Message over the selected first or second channel only in response to a selected phrase representation while permitting the third electronic device to hold the communication concurrently over the unselected second or first channel (col. 26, lines 27-39; see Fig. 10B; col. 28, line 59 – col. 29, line 7). Wherein, Johnson further discloses the third electronic device generates an out-of-band signal in response to a phrase representation selection and a channel representation selection (Fig. 9A and Fig. 10A).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the telecommunications infrastructure of Rosenthal to include the third electronic device generates an out-of-band signal in response to a phrase representation selection and a channel representation selection as taught by Johnson. One of ordinary skill in the art would have been lead to make such a modification to allow a third electronic device to retrieve a

phrase representation selection and a channel representation selection outside of the telecommunications infrastructure.

Regarding claim 31, the telecommunications infrastructure of claim 27, wherein Rosenthal does not disclose the phrase representation is selected from a group consisting of an icon, a symbol, a figure, a graph, a checkbox, a GUI widget and a graphics button.

Johnson discloses a telecommunication infrastructure (see Fig. 2 and Abstract), comprising: (a) a first electronic device coupled to the telecommunication infrastructure over a first channel (Fig. 2, 24); (b) a second electronic device coupled to the telecommunication infrastructure over a second channel (Fig. 2, 24); (c) a third electronic device coupled to the telecommunication infrastructure (Fig. 2, 24; col. 17, line 48 – col. 18, line 36), selecting the first channel or the second channel and selecting a phrase representation not necessarily in response to an incoming communication (an office attendant-type program user sending a Net Message to called party Mike; Fig. 10A; col. 28, lines 18-57); and (d) a processing device (communications system; Fig. 2, 50; col. 7, lines 16-47) coupled to the telecommunication infrastructure, capable of storing: 1) a phrase element associated with the phrase representation (col. 28, lines 18-57); and, 2) a software program for providing a Net Message over the selected first or second channel only in response to a selected phrase representation while permitting the third electronic device to hold the communication concurrently over the unselected second or first channel (col. 26, lines 27-39; see Fig. 10B; col. 28, line 59 – col. 29, line 7). Wherein Johnson further discloses the phrase representation is selected from a group consisting of an icon, a symbol, a figure, a graph, a checkbox, a GUI widget and a graphics button (Fig. 10A; col. 28, line 59 – col. 29, line 7).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the telecommunications infrastructure of Rosenthal to include the phrase representation is selected from a group consisting of an icon, a symbol, a figure, a graph, a checkbox, a GUI widget and a graphics button as taught by Johnson. One of ordinary skill in the art would have been lead to make such a modification to allow a user to easily select a phrase representation not utilizing an in-band signal.

Regarding claim 33, the telecommunication infrastructure of claim 27, wherein Rosenthal does not disclose the processing device is a computer coupled to the Internet.

Johnson discloses a telecommunication infrastructure (see Fig. 2 and Abstract), comprising: (a) a first electronic device coupled to the telecommunication infrastructure over a first channel (Fig. 2, 24); (b) a second electronic device coupled to the telecommunication infrastructure over a second channel (Fig. 2, 24); (c) a third electronic device coupled to the telecommunication infrastructure (Fig. 2, 24; col. 17, line 48 – col. 18, line 36), selecting the first channel or the second channel and selecting a phrase representation not necessarily in response to an incoming communication (an office attendant-type program user sending a Net Message to called party Mike; Fig. 10A; col. 28, lines 18-57); and (d) a processing device (communications system; Fig. 2, 50; col. 7, lines 16-47) coupled to the telecommunication infrastructure, capable of storing: 1) a phrase element associated with the phrase representation (col. 28, lines 18-57); and, 2) a software program for providing a Net Message over the selected first or second channel only in response to a selected phrase representation while permitting the third electronic device to hold the communication concurrently over the unselected second or first channel (col. 26,

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lines 27-39; see Fig. 10B; col. 28, line 59 – col. 29, line 7). Wherein Johnson further discloses the processing device is a computer coupled to the Internet (Fig. 2, 50; col. 8, lines 27-45).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the telecommunications infrastructure of Rosenthal to include the processing device is a computer coupled to the Internet as taught by Johnson. One of ordinary skill in the art would have been lead to make such a modification to allow the phrase representation to be retrieved via an out-of-band signal and to utilize resources outside of the telecommunications infrastructure.

24. Claims 39 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenthal, as applied to claim 35 above, in view of Johnson.

Regarding claim 39, the method of claim 38, wherein Rosenthal further discloses a display to view messages (col. 4, lines 46-53).

Rosenthal does not disclose said channel representation is displayed on a graphical user interface.

Johnson discloses a method for a user to communicate over multiple channels (see Fig. 8A: Lines 1-5), comprising steps of: (a) communicating over a first channel (wherein the office attendant-type program receives an incoming call for a particular user, Mike; Fig. 9B); (b) initiating a new communication, which is not necessarily responding to an incoming communication (an office attendant-type program user sending a Net Message to called party Mike; Fig. 10A; col. 28, lines 18-57), by performing the following steps: (1) selecting a second channel (sending a Net Message to Mike; Fig. 10A); (2) selecting a phrase (col. 28, lines 18-57); (3) generating a net message of the selected phrase; and (4) providing the net message over the

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selected second channel only while the first channel is on hold concurrently (col. 26, lines 27-39; see Fig. 10B; col. 28, line 59 – col. 29, line 7). Wherein Johnson further discloses said channel representation is displayed on a graphical user interface (Fig. 9A).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the method of Rosenthal to include said channel representation is displayed on a graphical user interface as taught by Johnson. One of ordinary skill in the art would have been lead to make such a modification to provide a graphical user interface that would allow the user to view multiple channels and select one to send an audible utterance to via the graphical user interface.

Regarding claim 41, the method of claim 40, wherein Rosenthal further discloses a display to view messages (col. 4, lines 46-53).

Rosenthal does not disclose said phrase representation is displayed on a graphical user interface.

Johnson discloses a method for a user to communicate over multiple channels (see Fig. 8A: Lines 1-5), comprising steps of: (a) communicating over a first channel (wherein the office attendant-type program receives an incoming call for a particular user, Mike; Fig. 9B); (b) initiating a new communication, which is not necessarily responding to an incoming communication (an office attendant-type program user sending a Net Message to called party Mike; Fig. 10A; col. 28, lines 18-57), by performing the following steps: (1) selecting a second channel (sending a Net Message to Mike; Fig. 10a); (2) selecting a phrase (col. 28, lines 18-57); (3) generating a net message of the selected phrase; and (4) providing the net message over the selected second channel only while the first channel is on hold concurrently (col. 26, lines 27-39;

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see Fig. 10B; col. 28, line 59 – col. 29, line 7). Wherein Johnson further discloses said phrase representation is displayed on a graphical user interface (Fig. 10A; col. 28, line 59 – col. 29, line 7).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the method of Rosenthal to include said phrase representation is displayed on a graphical user interface as taught by Johnson. One of ordinary skill in the art would have been lead to make such a modification to provide a graphical user interface that would allow the user to view multiple phrase representations, select one of the phrase representations, and send it to a selected channel via the graphical user interface.

Response to Arguments

25. Applicant's arguments filed 8-2-2005 have been fully considered but they are not persuasive. Please see all rejections in the Non-Final Office Action filed on 4-7-2005.

26. Applicant's arguments with respect to claims 1-41 have been considered but are moot in view of the new ground(s) of rejection. Please see all rejections above.

27. Accordingly, this action is **NON-FINAL**.

Conclusion

28. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- U.S. Patent No. 6,404,860 by Casellini discloses selecting an internal representation of a phrase element via a GUI and sending an audible utterance over a channel to a caller

29. Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450

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Alexandria, VA 22313-1450

Or faxed to:

(571) 273-8300 (for formal communications intended for entry)

Or call:

(571) 272-2600 (for customer service assistance)

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (571) 272-7542. The examiner can normally be reached on M-F 8:30-5:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

31. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LH

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November 6, 2005


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